

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. : 10/695,429
Applicant : David Mathieu
Filing Date : October 28, 2003
Title : Rotary Trimmer

TC/A.U. : 3724
Examiner : Phong H. Nguyen

Docket No. : ACME/192/US
Customer No. : 002543

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Honorable Sir:

APPEAL BRIEF

This brief follows Applicant's Notice of Appeal filed October 12, 2011 and contains the following sections under the headings and in the order set forth below as required by 37 C.F.R. 41.37(c)(1).

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The final page of Section VII bears the signature of Appellants' attorney.

I. REAL PARTY IN INTEREST

The real party in interest is the assignee of record, Acme United Corporation.

II. RELATED APPEALS AND INTERFERENCES

There is no other Appeal related to this application.

There are no known interferences or judicial proceedings related to this application.

III. STATUS OF CLAIMS

A. STATEMENT OF STATUS OF ALL CLAIMS IN THE APPLICATION

Claims 1-18, 30-32, 40-42 and 44 are pending in this application.

Claims 1-18 and 30-32 stand withdrawn from consideration.

Claims 19-29, 33-39, 43 and 45-47 are cancelled.

Claims 40-42 and 44 are rejected.

No claims are allowed.

No claims are objected to.

B. CLAIMS ON APPEAL

Claims 40-42 and 44 are the subject of this Appeal.

IV. STATUS OF AMENDMENTS

A Final Office Action rejecting claims 40-42 and 44 was mailed July 14, 2011 (hereinafter "Final Action"). One of the grounds of rejection set forth in the final Action was a rejection of claims 40-42 and 44 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. The Examiner asserted that the phrase in claim 40, "without the cutting blade being

disconnected from the hub and without the hub being disconnected from the blade guard” was not supported by the original disclosure.

A Response under 37 C.F.R. §1.116 was filed on September 1, 2001 in response to the Final Action. That response simply amended claim 40 by deleting the phrase that the Examiner asserted was not supported by the original disclosure. Applicant argued that the Response eliminated one issue and placed the application in better form for consideration on appeal and should be entered under the provisions of 37 C.F.R. §1.116.

The Examiner replied in an Advisory Action mailed Sept. 22, 2011 that the proposed amendment was not deemed to place the application in better form for appeal by materially reducing the issues for appeal. As a result, the proposed Response under 37 C.F.R. §1.116 was not entered.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Claim 40 is directed to a blade-guard assembly (Fig. 6, Page 10, lines 11-12) for use in a rotary trimmer. The blade-guard assembly comprises a cutting blade 50 having a plurality of apertures 54 (Fig. 7, Page 10, lines 28-31) and a hub 55 connected to the cutting blade 50 via the plurality of apertures 54 (Page 11, lines 4-7).

A blade guard 44 is secured to the hub 55 and forms the blade-guard assembly with the cutting blade 50. The blade guard 44 covers the cutting blade 50 such that at least a portion of the cutting blade 50 is exposed for cutting (Fig. 6). The blade guard 44, cutting blade 50 and hub 55 are a unitary structure such that the blade-guard assembly is removable from and placeable on the rotary trimmer as a unit without the cutting blade being disconnected from the hub and without the hub being disconnected from the blade guard (Fig. 6, Page 10, lines 11-17).

Claim 41 sets forth that there is a central aperture disposed in the central region of the cutting blade 50 and the plurality of apertures 54 are disposed about the central aperture 54 (Fig. 7).

Claim 42 sets forth that the plurality of apertures 54 are disposed angularly around and are smaller than the central aperture (Fig. 7).

Claim 44 sets forth that the hub and cutting blade 50 are integrally connected using the plurality of apertures (Page 10, line 32-Page 11, line 7).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

A. Whether claims 40-42 and 44 fail to comply with the written description describing as required under 35 U.S.C. §112, first paragraph.

B. Whether claims 40-42 and 44 are anticipated under 35 U.S.C. §102(b) by Matthai et al. (5,702,415).

C. Whether claims 40-42 are anticipated under 35 U.S.C. §102(b) by Schulz et al. (5,765,289).

VII. ARGUMENT

A. CLAIMS 40-42 AND 44 COMPLY WITH THE WRITTEN RESTRICTION REQUIREMENT OF 35 U.S.C. §112.

Claims 40-42 and 44 stand rejected under 35 USC 112, first paragraph, for failing to comply with the written description requirement. The Examiner maintains that these claims contain subject matter which is not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventor, at the time the application was filed, had possession of the claimed invention.

The Examiner asserts that in claim 40, the phrase “without the cutting blade being disconnected from the hub and without the hub being disconnected from the blade guard” is not supported by the original disclosure.

There is no *in haec verba* requirement for support of a newly added claim limitation. Such limitations may be supported in the specification through express, implicit or inherent disclosure. (See MPEP 2163, I, B).

As stated in *All Dental Prodx LLC v. Advantage Dental Products Inc.*, 309 F.3d 774, 64 USPQ2d 1945 (Fed. Cir. 2002):

In order to comply with the written description requirement, the specification "need not describe the claimed subject matter in exactly the same terms as used in the claims; it must simply indicate to persons skilled in the art that as of the [filing] date the applicant invented what is now claimed." *Eiselstein v. Frank*, 52 F.3d 1035, 1038, 34 USPQ2d 1467, 1470 (Fed. Cir. 1995) (citing *Vas-Cath*, 935 F.2d at 1562, 19 USPQ2d at 1115, and *In re Wertheim*, 541 F.2d 257,265, 191 USPQ 90, 98 CCPA 1976))

Possession of the invention may be shown in a variety of ways including description of an actual reduction to practice, or by showing that the invention was ready for patenting such as by the disclosure of drawings or structural chemical formulas that show that the invention was complete, or by describing distinguishing identifying characteristics sufficient to show that the applicant was in possession of the claimed invention. See, e.g., *Pfaff v Wells Elecs., Inc.*, 525 U.S. 55, 68, 119 S.Ct.304, 312, 48 USPQ2d 1641, 1647 (1998);

In fact, it has been held that even drawings alone under proper circumstances can provide a "written description" of an invention as required by 35 USC §112. See *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1565, 19 USPQ2d 1111, 1118 (Fed. Cir. 1991).

Given that the phrase "without the cutting blade being disconnected from the hub and without the hub being disconnected from the blade guard" is not found verbatim in the original specification, the question is: is such a phrase inherent in the original language of the specification and drawings? It is submitted that the answer to this question is yes.

This feature is clearly shown in the drawings and is inherent in the language of the original specification. Fig. 6 clearly shows a blade-guard assembly including a blade, a blade guard and a hub connected together and being removed from the rotary trimmer without the blade being disconnected from the hub without the hub being disconnected from the blade-guard.

The original specification states on page 10, lines 11-14 that the guard is connected to the cutting blade to form an **integral** blade-guard assembly. The specification goes on to state on page 10, lines 12-17 that the cutting blade is secured to the guard by a clip, or any other suitable way, to form an integral piece, so that when a new and different cutting blade is desired, the **entire** blade-guard assembly is removed and replaced on the blade carriage. This language clearly indicates that the guard and cutting blade are a unit and are replaced without being disconnected.

Certainly, it is inherent in this description of the guard and cutting blade being integral, taken along with Fig. 6, that the entire blade-guard assembly is removable and replaceable on the rotary trimmer **without** the blade being disconnected from the hub and the hub being disconnected from the blade guard. Fig. 6 clearly shows that blade and blade guard are not disconnected when removed from the rotary trimmer.

It is submitted that based upon the drawings and the above referenced description in the originally filed specification, the objected to language is inherent in the original disclosure and claim 40, and dependent claims 41, 42, and 44, are in compliance with the written description of 35 USC §112 and the Examiner's rejection of the claims for failure to comply with 35 USC §112 is in error.

B. CLAIMS 40-42 and 44 ARE NOT ANTICIPATED BY MATTHAI et al. AND ARE THEREFORE PATENTABLE.

Claims 40-42 and 44 stand rejected under 35 USC §102(b) as being anticipated by Matthai et al. (5,702,415).

Claim 40, the only independent claim on appeal, is directed to a blade-guard assembly for use in a rotary trimmer comprising a cutting blade having a plurality of apertures. A hub is secured to the cutting blade via the plurality of apertures. A blade guard is secured to the hub and forms a blade-guard assembly with the cutting blade. The blade guard covers the cutting blade such

that at least a portion of the cutting blade is exposed for cutting. The blade guard, cutting blade and the hub are a unitary structure so that the blade-guard assembly is removable from, and placeable on, the rotary trimmer as a unit without the cutting blade being disconnected from the hub and without the hub being disconnected from the blade guard.

The claim clearly sets forth that the blade-guard assembly is a unitary structure comprising the blade guard, the hub and the cutting blade that together form a unit. This unit is removable from, and placeable on, the rotary trimmer without the cutting blade being disconnected from the blade guard or hub.

The Examiner has cited the Matthai et al. reference in connection with claim 40 as showing a rotary trimmer comprising a cutting blade 9 having a plurality of apertures, a hub (12, 81) connected to the cutting blade via the plurality of apertures and a blade guard 86 secured to the hub.

As stated in *Therasense, Inc. v. Becton, Dickinson & Co.*, 593 F.3d 1325, 93 USPQ2d 1481 (Fed. Cir. 2010):

The way in which the elements are arranged or combined in the claim must itself be disclosed, either expressly or inherently, in an anticipatory reference. "Anticipation requires the presence in a single prior art disclosure of all elements of a claimed invention arranged as in the claim." *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548 (Fed. Cir.1983). The requirement that the prior art elements themselves be "arranged as in the claim" means that claims cannot be "treated...as mere catalogs of separate parts, in disregard of the part-to-part relationships set forth in the claims and that give the claims their meaning." *Lindemann Maschinenfabrik GMBH v. Am. Hoist & Derrick Co.*, 730 F.2d 1452, 1459 (Fed. Cir.1984). "[U]nless a reference discloses within the four corners of the document not only all of the limitations claimed but also all of the limitations *arranged or combined in the same way as recited in the claim*, it cannot be said to prove prior invention of the thing claimed and, thus, cannot anticipate under 35 U.S.C. §102." *Net*

MoneyIN, Inc. v. VeriSign, Inc., 545 F.3d 1359, 1371 (Fed. Cir. 2008) (emphasis added).

It is submitted that the Matthai et al. reference does not satisfy the criteria for anticipation as set forth in the above citation. The Matthai et al. reference does not disclose all of the elements of the claimed invention arranged as in the claim.

In the arrangement shown in the Matthai et al. reference, the uncovered cutting blade is inserted by itself between a cap 80 and the top of a cup washer 60. After the blade is properly positioned, a hold down screw is tightened to hold the blade in place. During the entire installation process, the blade is not connected to any type of blade guard.

During the removal of the blade, the process is reversed. The hold down screw is loosened, and the blade lifted above the drive pins 70. The blade is then pushed rearward and raised upward along the guide pins 71 and past the cup washer 60. The blade is then slid forwardly out from between the top of the cup washer 60 and the bottom of the handpiece cap 80. As in the installation process, at no time during the removal process is the blade attached to a blade guard. When the blade is removed, it is not protected by a blade guard.

The structure 80 in the device of the Matthai et al. reference, which the Examiner considers to be the blade guard, is a cap that is removably secured to the top wall of the housing 13 of the hand piece before the installation of the blade. This cap 80 is not connected in any way to the blade that would enable it to be removed from, and to be placed on, the hand piece as a unit with the blade. The cap remains attached to the hand piece during the removal of and installation of the blade.

The Examiner considers the structure indicated by the reference numerals 12, 81 of the Matthai et al. reference to be equivalent to the hub that is set forth in the claims. The structure indicated by reference numeral 12 is a chuck that is mounted in the hand piece. Reference numeral 81 refers to the top wall of the housing. Neither of these structures is attached to a blade or blade guard so that

they are removable with the blade when the blade is removed.

Claim 40 specifically requires that the cutting blade be secured to the hub and that the hub in turn is connected to the blade guard forming a blade-guard assembly that is removable from and placeable on the rotary trimmer as a unit. Claim 40 also requires that the blade-guard assembly is removable from and placeable on the rotary trimmer as a unit without the cutting blade being disconnected from the hub and without the hub being disconnected from the blade guard.

Such an arrangement is impossible in the Matthai et al. reference. What the Examiner considers to be the hub and blade guard in the device of the Matthai et al. reference remain attached to the tool when a new blade is removed and inserted. The "hub" and "blade guard" of the device of the Matthai et al. references are thus disconnected from the blade when the blade is removed and installed. There is no structure shown in the Matthai et al. reference that can, under any reasonable interpretation, be considered a blade-guard assembly as claimed.

As the Matthai et al. reference does not show or disclose all the elements of the claimed invention arranged as set forth in claim 40, that reference cannot be said to anticipate the claim. Accordingly, claim 40 and its dependent claims 41, 42 and 44 are patentable over the Matthai et al. reference.

C. CLAIMS 40 - 42 ARE NOT ANTICIPATED BY SCHULTZ et al. AND ARE THEREFORE PATENTABLE.

Claims 40-42 stand rejected under 35 U.S.C. §102(b) as being anticipated by Schulz et al. (5,765,289).

As to claim 40, the Examiner maintains that the Schulz et al. reference teaches a blade-guard assembly for a rotary trimmer comprising a cutting blade 22 having a plurality of apertures, a hub 32, and blade guard 42 secured to the hub and forming a blade-guard assembly. The Examiner maintains that the three small U-shaped "apertures" on the circumference of the big central aperture are

the same as the apertures referred to in the claim.

In the Schulz et al. device, the blade is attached to the head 16 of the cutter 10 by means of a headed shaft 32 that extends through the guard 42, cutting blade 22 and an aperture in the head 16 of the cutter 10. The headed shaft is retained in place by a retainer nut 38. As can clearly be seen in Fig. 5 of the Schulz et al. reference, in order for the blade to be removed, the retainer nut 38 must be removed from the shaft 32, the shaft 32 and guard removed from the body of the cutter 16 and then the blade removed by itself. There is no disclosure of a blade, hub and blade guard being removable from, and replaceable on, the cutter as a unit to change the blade. The blade guard and shaft of the Schulz et al. device are not meant to be replaceable as they are an integral part of the cutter.

In the Schulz et al. reference, what is considered to be the blade guard, hub and blade are not removable from, and placeable on, the cutter as a unitary structure without the blade being disconnected from the hub and without the hub being disconnected from the blade guard. As shown in Fig. 5, when the shaft 32 is removed from the cutter, the blade 24 is disconnected from the guard 42 and hub (shaft 32).

Additionally, what the Examiner considers to be a plurality of apertures in the Schulz et al. reference is merely part of the shape of the single central aperture. Thus, there is not a plurality of apertures as claimed. In addition, the U-shaped portion of the central aperture does not cooperate in anyway with the shaft (hub) as claimed.

Regarding claims 41 and 42, as there is no plurality of apertures shown in the Schulz et al. reference, there are no "apertures spaced around a central aperture (claim 41) nor is there a plurality of apertures "smaller than the central aperture" (claim 42).

As the Schulz et al. reference does not show or disclose all the elements of the claimed invention arranged as in claims 40 – 42 and 44, this reference does not meet the criteria for anticipation as set forth in *Therasense, Inc.* quoted above and cannot be held to anticipate the claims. Accordingly, claim 40, and its

dependent claims 41 and 42 are patentable over the Schulz et al. reference.

F. CONCLUSION

As discussed above, the claims satisfy the requirements of 35 USC §112 in that the phrase “without the cutting blade being disconnected from the hub and without the hub being disconnected from the blade guard” is supported by the original disclosure.

Additionally, for the reasons set forth above, Applicant submits that the claims are not anticipated by the cited art and are patentable over such art. Neither the Matthai et al. nor Schulz et al. patents anticipate the blade-guard assembly of the present invention.

Applicant requests that the Honorable Board reverse the Examiner on all grounds of rejection of claims 40-42 and 44.

Respectfully submitted,

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VIII. CLAIMS APPENDIX

40. A blade-guard assembly for use in a rotary trimmer comprising:
a cutting blade having a plurality of apertures;
a hub connected to the cutting blade via the plurality of apertures; and
a blade guard secured to the hub and forming the blade-guard assembly
with said cutting blade, the blade guard covering the cutting blade such that at
least a portion of the cutting blade is exposed for cutting, said blade guard,
cutting blade and hub being a unitary structure so that said blade-guard
assembly is removable from, and placeable on, the rotary trimmer as a unit
without the cutting blade being disconnected from the hub and without the hub
being disconnected from the blade guard.
41. The blade-guard assembly of Claim 40, further comprising a central
aperture disposed in a central region of the cutting blade; and wherein the
plurality of apertures are disposed about the central aperture.
42. The blade-guard assembly of Claim 41 wherein the plurality of apertures
are disposed angularly around and are smaller than the central aperture.
44. The blade-guard assembly of claim 40 wherein the hub and the cutting
blade are integrally connected using the plurality of apertures.

IX. EVIDENCE APPENDIX
(No Content)

X. RELATED PROCEEDINGS APPENDIX

(No Content)

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